

REMARKS

Claims 1-8, 10-14 and 17-33 are pending in the present application. Claims 1-8, 10-14 and 17-33 stand rejected. No claims have been allowed. No claims have been canceled. Claims 10 and 32 have been amended.

I. Summary of Telephonic Interview

The Examiner is hereby acknowledged and thanked for the courtesy extended during the telephonic interview of January 31, 2005 between Examiner Pillai and the undersigned attorney. The pending claims, current Office Action and prior art were all discussed during this telephonic interview, and it was noted that the primary prior art reference being used is issued to the same lead inventor as the lead Applicant in the present case. Interpretation of several claim terms in the broadest possible manner was also discussed, and it was also noted that the "operator" and "user" as stated in the present claims were different parties, with the user preferably being an employee or personnel of the operator. Agreement was not reached with respect to the patentability of any particular wording of the presently pending claims, and it was proposed that Applicants submit a Rule 132 Declaration and/or amend the present claims to overcome the present rejections, both of which have been accomplished hereby.

II. Rejections under 35 U.S.C. § 102

Claims 1-8, 10-14 and 17-33 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 6,682,421 B1 to Rowe, et al. ("the '421 patent"). In particular, the Office Action notes that 35 U.S.C. § 102(e) requires "the invention was described in . . . a patent granted on an application for patent *by another*" (emphasis added). Furthermore, the Office Action also states that "Rowe discloses . . . displaying only the navigational selectable elements the user is allowed to view, wherein the resulting display is customized to the user

based at least in part upon the first input and second input (column 7, lines 35-60)."

Applicants respectfully traverse these § 102(e) rejections.

Prior Art Must Be By "Another"

In order to anticipate a claim under 35 U.S.C. § 102(e), an appropriate prior art reference must be *by another*. Although there are different co-inventors in both the present application and the '421 patent, the first named inventor to both cases is the same, Richard E. Rowe. In fact, Mr. Rowe is the inventor who conceived of much of the material set forth in the '421 patent, including the primary passage being used for all of the pending anticipatory rejections, that being column 7 line 35 through column 8 line 10. A pair of separate Rule 132 Declarations setting forth these facts and signed by Mr. Rowe and his only co-inventor to the '421 patent, Michael Oberberger, are included herewith. It is believed that these declarations effectively establish that the passage being used to maintain the present rejections is not prior art to the present case. Because a rejection under 35 U.S.C. § 102(e) cannot be maintained where the prior art reference used is not "by another," or where the passages used from that reference can be solely attributed to an inventor of a pending application, Applicants respectfully request the withdrawal of the pending § 102(e) rejections for at least this reason.

All Claim Limitations Must Exist in the Prior Art

Also, in order to anticipate a claim, a reference must contain every material limitation of that claim. Each of independent claims 1, 10 and 32 recites the step of "displaying [] navigation selectable elements [accessible to said user / said user is allowed to view], *wherein said resulting display is customized to the user based at least in part upon said first input and said second input.*" (emphasis added). Further, independent claim 17 recites, "wherein said graphical user interface is adapted to display said navigation selectable elements in a plurality of configurations dependent upon a configuration of a station on which said graphical user interface is displayed or a user profile, and *wherein said resulting display is customized to the*

user based at least in part upon said first input and said second input." (emphasis added). Accordingly, all pending claims require a limitation of displaying navigation selectable elements in a specific manner, such that the resulting display to a given user is customized based upon both an input from the given user (first input) and another input from an operator (second input). Although it is certainly possible for the invention of the '421 patent to practice the present invention as claimed, Applicants respectfully submit that no proper showing has been made that the '421 patent discloses such a limitation. Applicants request further clarification of where this particular limitation exists in the '421 patent, and/or whether any level of inherency is being assumed with respect to that which is taught by the '421 patent. Because such a limitation must be shown to be within the '421 patent for an anticipation rejection to be proper, however, the pending § 102(e) rejections for independent claims 1, 10, 17 and 32 cannot stand for at least this additional reason.

Furthermore, Applicants respectfully submit that the '421 patent has not been shown to disclose several other specific claim limitations. In particular, the Office Action points to column 7 lines 35-60 of the '421 patent as specifically showing all 7 steps of independent claim 1 and all 7 steps of independent claim 10, as well as many limitations of independent claims 17 and 32. The Office Action further alleges that remaining limitations of independent claims 17 and 32 are found at column 7 line 61 through column 8 line 7 of the '421 patent. In fact, it is also asserted that the specific passage from column 7, line 35 through column 8 line 7 of the '421 patent accounts for all additional limitations provided by present dependent claims 2-7, 18, 20, 25 and 28, among others. Applicants respectfully submit, however, that while the present invention might certainly be used in conjunction with that which is taught by the '421 patent, that an appropriate specific showing of where each individual step and claim limitation is taught by the '421 patent has not been made. Because each of dependent claims 2-8, 11-14, 18-31 and 33 all depend from one of independent

claims 1, 10, 17 or 32, the pending § 102(e) rejections for these claims similarly cannot stand for at least the same reasons as those given above for claims 1, 10, 17 and 32. Applicants thus respectfully request the withdrawal of these § 102(e) rejections as well.

Claim Amendments

Nevertheless, in the interests of expediting prosecution of the present application, Applicants have currently amended independent claims 10 and 32 to more clearly define the scope of that which is being claimed. Applicants respectfully reserve the right to pursue the broader versions of these claims in this or a future continuation or divisional application, as may become appropriate.


In particular, claims 10 and 32 have been amended to require that the recited operator is an employer of the recited user or given user. In this regard, the first input from the user and the second input from the operator come from an employee and employer, with both of these separate inputs then being used to customize the resulting display, as required later in each claim. Applicants respectfully submit that the pending claims are patentable over the prior art of record for at least this additional reason.

CONCLUSION

Applicants respectfully submit that all claims are in proper form and condition for patentability, and request a Notification of Allowance to that effect. It is believed that no fee is due at this time. Should any fee be required for any reason related to this document, however, then the Commissioner is hereby authorized to charge such fee or fees to Deposit Account No. 50-0388, referencing Docket No. IGT1P119. The Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below with any questions or concerns relating to this document or application.

Respectfully Submitted,
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